

ATTORNEY DOCKET NO
509854.500172

PATENT
U.S. 10/706,014

Remarks/ Arguments

In response to the Office Final Action mailed July 1, 2008, Applicants respectfully request that the Examiner reconsider the rejections of the claims.

Claims 1-2, 4-5, 7-10, 12-15, and 17-20 remain.

Claim 1 has been amended to include the features of original dependent Claim 3.

As an initial matter, Applicants respectfully submit that the Examiner's assertion that that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action" is in error. The amendments made in Applicants' response of October 10, 2007 combined the subject matter of selected dependent claims with their associated independent claims. In other words, Applicants' claimed subject matter remained within the scope of the claims as originally filed. Hence, the newly cited *Temple* and *Biahut* references, discussed in detail below should have been either raised earlier in the present examination or the present Office Action should not have been made Final, thereby allowing Applicants the fully opportunity to address the newly cited references.

Claims 1 -2, 4 – 5, 7 – 10, and 12 - 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Temple*, U.S. Patent Publication 2003/0198463. Applicants respectfully traverse these rejections.

A reference must be enabling in order to place the allegedly disclosed matter in the possession of the public. In other words, the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it. *Akzo N.V. v. United States ITC*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990).

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In this case, and contrary to the Examiner's submission, Paragraph [0024] of *Temple* does not provide any suggestion that decompressed index frames can be utilized to generate a customized menu. Paragraph [0024] of *Temple* only states:

"According to one embodiment, the fast mode 34 produces a static menu with title text only. The quality mode 36 produces a static menu with title and chapter thumbnails. The static menu will be discussed further herein below."

Moreover, a computer search of *Temple* reveals that neither the term "index frame" nor the term "decompress" are utilized in *Temple*. (While Figure 1 of *Temple* shows an "other source" of video information 20, such as a DVD, *Temple* never discusses how data extracted from such "other source" is processed and clearly does not discuss either the extraction of index frames or the decompression of extracted index frames.)

Advantageously, index frames are associated with corresponding video segments such that decompressing selected index frames allows for buttons to be directly created on the menu that allow a quick jump to the corresponding segment. (*Application*, Paragraph [0027]). According to the present principles, an author simply extracts the index frame, decompresses it, and directly creates the button to the exact video segment.

According to the procedure disclosed in *Temple*, an author must use DV timestamps and / or time delays to select chapter breaks within the presentation being generated. (*Temple*, Paragraph [0043]). The author then has to extract material for a thumbnail, using either a luma histogram analysis or by manually selecting a frame. (*Temple*, Paragraph [0044]). Finally, a static menu is auto-generated and transcoded through a process that *Temple* also does not fully describe. (*Temple*, Paragraph [0045]).

Given that *Temple* does not teach or suggest generating menus by decompressing index frames. Applicants therefore respectfully submit that the

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rejections of Claims 1 -2, 4 – 5, 7 – 10, and 12 - 14 as obvious in view of *Temple* should be withdrawn.

Claims 15, and 17 - 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Temple*, in further view of *Biahut*, U.S. Patent 5,570,126. Applicants respectfully traverse these rejections.

The differences between *Temple* and the present claims have been described in detail above. These differences are not remedied by the teachings of the *Biahut*. As with *Temple*, *Biahut* does not teach or suggest generating menus by decompressing index frames from a DVD. Instead, *Biahut* only discloses a system for combining multiple multimedia signals into a single composite signal. (*Biahut*, Abstract). *Biahut* never touches on the features of decompressing index frames for menu generation.

Applicants therefore respectfully submit that the rejections of Claims 15, and 17 - 20 as obvious in view of the *Temple* and *Biahut* should be withdrawn.

No new matter has been added; the claims have been merely amended to more particularly claim the subject matter Applicants believe is inventive. Applicants respectfully submit that the Claims as they now stand are patentably distinct over the art cited during the prosecution thereof.

With the addition of no new claims, no additional filing fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account Number 20-0821 of Thompson & Knight LLP.

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If the Examiner has any questions or comments concerning this paper or the present application in general, the Examiner is invited to call the undersigned at (214) 969 - 1749.

Respectfully submitted,

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